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EXAMINER

BOWERS, NATHAN ANDREW

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOM CLAES,
JEAN-PASCAL ZAMBAUX, STEVE VANHAMEL,
CHRISTOPHE BRAET, FLORENCE BOSCO, and JOSE CASTILLO

Appeal 2015-004761
Application 12/299,271
Technology Center 1700

Before KAREN M. HASTINGS, GEORGE C. BEST, and
JULIA HEANEY, *Administrative Patent Judges*.

BEST, *Administrative Patent Judge*.

DECISION ON APPEAL

The Examiner finally rejected claims 161, 162, 164–172, and 174–206 of Application 12/299,271 under 35 U.S.C. § 103(a) as obvious. Final Act. (May 12, 2014). Appellants¹ seek reversal of this rejection pursuant to 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6.

We REVERSE because the Examiner has not provided a sufficiently detailed statement of the findings of fact and reasons underlying the legal

¹ Pall Life Sciences Belgium BVBA is identified as the real party in interest. Appeal Br. 3.

conclusion that the subject matter of the appealed claims would have been obvious to a person of ordinary skill in the art at the time of the invention. We emphasize that this reversal is procedural in nature. We express no opinion on the merits (or lack thereof) of the rejection set forth in the final action.

BACKGROUND

The '271 Application's Specification describes methods and apparatus for the industrial or laboratory mixing of gases and liquids that may be used in bioreactors. Spec. ¶ 2. In particular, Appellants describe mixing apparatus that can be used with a disposable container. *Id.* ¶¶ 8–13.

Claim 161 is representative of the '271 Application's claims and is reproduced below:

161. A material processing apparatus comprising:

a hollow tank having an interior bounded by at least one interior wall;

a mixing paddle disposed and adapted to travel within the interior of the tank, the paddle being adapted to engage a support rod mechanically coupleable to receive kinetic energy from a kinetic energy source; and

a functional element arranged to travel with the mixing paddle within the interior of the tank, the functional element including any of:

(a) at least one sensor in sensory communication with the interior of the tank;

(b) a material extraction conduit in at least selective fluid communication with the interior of the tank and adapted to permit the extraction of material from the interior of the tank;

(c) a material addition conduit in at least selective fluid communication with the interior of the tank and adapted

to permit the addition of a material to the interior of the tank; and

(d) a heat exchange element in thermal communication with the interior of the tank and adapted to permit the addition or removal of thermal energy from the interior;

wherein the tank comprises a flexible sleeve having an open end proximate to a wall of the tank, having an end protruding into the interior, having at least one exterior wall, and defining a cavity containing the mixing paddle, with the at least one interior wall of the tank and the at least one exterior wall of the sleeve enclosing a volume, such that the sleeve serves as an isolation barrier impermeable to any fluid of the volume;

wherein the functional element is adapted to interact with the flexible sleeve.

Appeal Br. 22–23 (Claims App.).

REJECTION

On appeal, the Examiner maintains the following rejection:

1. Claims 161, 162, 164–172, and 174–205² are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Zambaux,³ Forschner,⁴ Donofrio,⁵ Müller,⁶ and Schmid.⁷
Answer 2.

² On November 15, 2014, Appellants filed an amendment canceling claim 206. The amendment was entered on December 2, 2014.

³ US 2005/0078552 A1, published April 14, 2005.

⁴ US 6,439,756 B1, issued August 27, 2002.

⁵ US 4,426,450, issued January 17, 1984.

⁶ US 3,925,165, issued December 9, 1975.

⁷ US 7,659,108 B2, issued February 9, 2010.

DISCUSSION

In the Final Action, the Examiner concludes: “Claims 161, 162, 164–172 and 174–206 are rejected under 35 U.S.C. [§] 103(a) as being unpatentable over Zambaux (US 20050078552) in view of Forschner (US 6439756), Donofrio (US 4426450), Muller (US 3925165) and Schmid (US 7659108).” Final Act. 3. The Examiner then sets forth slightly less than 2 ½ pages of discussion regarding the content of each of the five references. This discussion does not contain any findings of fact relating the content of the prior art to a particular limitation recited in any claim. The Examiner then discusses dependent claims 162, 178, and 187. Final Act. 5. These are the only claims discussed with any specificity in the entirety of the rejection.

In the Answer, the Examiner “clarifies” the grounds of rejection as follows:

It is critically important to note that this is not a “five-way” rejection. Claims 161, 182 and 198 are “Markush-type” claims that recite a plurality of alternatively useable functional elements (a)-(d), (a)-(g) and (a)-(c). Using claim 161 as a guide:

(a) at least one sensor . . . is rejected over Zambaux in view of Muller;

(b), (c) a material extraction/addition conduit . . . is rejected over Zambaux in view of either Forschner or Donofrio, and

(d) a heat exchange element . . . is rejected over Zambaux in view of Schmid.

In other words, the rejections of record contemplate multiple ways in which one of ordinary skill would have been motivated to combine different prior art functional elements with the mixing paddle of Zambaux. Indeed, the rejection includes different “two-way” combinations, such that any one of which is sufficient to read on the claims. It is therefore possible for the Patent Trial and Appeal Board to not agree with

the Examiner as to correctness of one combination (e.g. Zambaux with Schmid - adding a heat exchange element to Zambaux's mixing paddle) while affirming another combination (e.g. Zambaux with Forschner - adding a conduit to Zambaux's mixing paddle), thereby affirming the rejection as a whole.

Answer 2–3 (*italicized emphasis added*).

Thus, according to the Answer, the '271 Application faces four distinct grounds of rejection rather than the single ground of rejection indicated in the Final Action.

The Answer, therefore, compounds the problems with the statement of rejection set forth in the Final Action. While the portion of the Answer quoted above establishes the Examiner's intent to reject claims 161, 182, and 198 as unpatentable over each of the four combinations of prior art identified in the Answer, the Examiner still has not provided a clear explanation of how each of those combinations should be applied to claim 161. Nor has he provided *any* substantive explanation of the application of each combination to claims 182 and 198. Furthermore, the Examiner has not provided *any* explanation of which of the prior art combinations applies to each of the dependent claims.

The Examiner's failure to provide a reasoned explanation of the basis for the rejection of each of the '271 Application's claims requires reversal. It may well be that some or all the claims are unpatentable over some or all of the asserted combinations of prior art, but our mandate is to review what the Examiner has done on the basis of the reasons provided in the record.⁸

⁸ Although we can enter new grounds of rejection in the course of deciding an appeal, *see* 37 C.F.R. § 41.50(b), we decline to do so here because the Examiner has not entered a complete rejection in the first instance.

To borrow an image from the 7th Circuit, we are not truffle-hunting pigs looking for reasons that the Examiner has not expressly stated in the record before us to affirm a rejection. *See U.S. v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) (“Judges are not like pigs, hunting for truffles buried in briefs.”).

In view of the foregoing, we reverse the rejection of claims 161, 162, 164–172, and 174–205 as unpatentable over the combination of Zambaux and any one of Forschner, Donofrio, Müller, or Schmid. We emphasize that our reversal is based upon the Examiner’s failure to provide the necessary statement of the basis for each of the rejections and not upon the merits of any such rejection.

CONCLUSION

For the reasons set forth above, we reverse the Examiner’s rejection of claims 161, 162, 164–172, and 174–205 of the ’271 Application. We emphasize that this reversal is procedural in nature. We express no opinion regarding the merits (or lack thereof) of the grounds of rejection set forth in the Final Action.

When the ’271 Application is returned to the Examiner for further action, the Examiner remains free to withdraw the finality of the May 12, 2014 Final Action and to enter a new rejection of any or all of the claims on appeal as unpatentable over any appropriate combination of Zambaux, Forschner, Donofrio, Müller, and Schmid. In so doing, however, the Examiner must provide a sufficiently detailed statement of the factual findings and reasoning underlying the rejection to enable Appellants to understand and substantively respond to the rejection and to allow the Board

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to meaningfully review the merits of the rejection based upon the contents of the record.

REVERSED